

Application No.: 10/572,590

REMARKS

Claim 1 is independent and stands rejected under 35 U.S.C. § 102 as being anticipated by Tanaka et al. '200 ("Tanaka"). This rejection is respectfully traversed for the following reasons.

Claim 1 recites in pertinent part, "said element M is uniformly distributed in said particle, and said element L is distributed more in a surface portion of said particle than an inside of said particle." The Examiner alleges that the aforementioned feature is inherent because "Tanaka uses the same approach to making the compound as that claimed." However, it is respectfully submitted that Tanaka does not use the same approach to making the compound. As acknowledged by the Examiner, "inherency may not be established by probabilities or possibilities," *Scaltech Inc. v. Retec/Tetra*, 178 F.3d 1378 (Fed. Cir. 1999). For the reasons that follow, it is respectfully submitted that the disclosed manufacturing process of Tanaka in fact would not result in the claimed structural arrangement, much less inherently do so.

In order to effect the relative arrangement of M and L, according to one aspect of the present invention, preparation of respective materials are conducted using the **combination** of the coprecipitation method and the external addition method. In contrast, as expressly disclosed in paragraph 62 of Tanaka, a positive electrode active material is prepared by mixing all the raw materials and then baking the mixture in a dry air flow. That is, Tanaka expressly discloses using only the external addition method. Tanaka is completely silent as to the coprecipitation method, let alone the combination of the coprecipitation method and external addition method.

By combining the coprecipitation method and the external addition method, it can be made possible to obtain a positive electrode active material in which element M is uniformly dispersed inside the particle and element L is distributed more on the surface layer than inside the particle. In contrast, as expressly described in paragraphs 108 and 109 of Applicants'

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specification, the claimed structural arrangement is not effected when only one of the coprecipitation method and external addition method is used. As noted above, in Tanaka, only an external addition method is used, so that the claimed structural arrangement is not effected. Such results are summarized in Table 2 on page 46 of Applicants' specification and detailed in the corresponding written description thereof, in which batteries A21 and A22 use only the coprecipitation method and the external addition method (as in Tanaka), respectively, rather than combining them as done for battery A4. Accordingly, Tanaka does not anticipate claim 1.

Moreover, it is respectfully submitted that the claimed combination can effect new and unexpected results thereby evidencing criticality thereof. For example, taking the trend for a higher charge voltage into consideration, it is desired that a battery has a recovery rate after storage of 70% or more (*see* paragraph 98 of Applicants' specification). However, battery A21 using the coprecipitation method only and battery A22 using the external addition method only each have, at a charge voltage of 4.4 V, a recovery rate of lower than 70% (*see* Table 2 on page 46 of Applicants' specification).

"All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970).

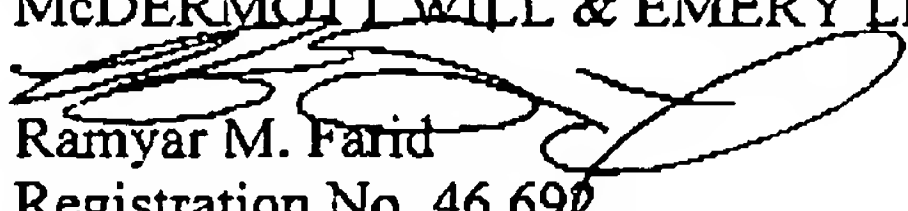
As anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed, either expressly or inherently (noting that "inherency may not be established by probabilities or possibilities", *Scaltech Inc. v. Retec/Tetra*, 178 F.3d 1378 (Fed. Cir. 1999)), in a single prior art reference, *Akzo N.V. v. U.S. Int'l Trade Commission*, 808 F.2d 1471 (Fed. Cir. 1986), based on the forgoing, it is submitted that Tanaka does not anticipate claim 1, nor any claim dependent thereon. Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the

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independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claim 1 is patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination. Based on the foregoing, it is respectfully submitted that all pending claims are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejections under 35 U.S.C. § 102/103 be withdrawn.

CONCLUSIONS

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below. To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,
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